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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|---------------------------|------------------|
| 10/748,364 | 12/30/2003 | Kenneth A. Walker JR. | 03-010 | 7796 |
| 37420 | 7590 | 01/17/2007 | | |
| VISTA PRINT USA INC. ATTN: PATENT COUNSEL 100 HAYDEN AVENUE LEXINGTON, MA 02421 | | | EXAMINER JONES, HUGH M | |
| | | | ART UNIT 2128 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | | MAIL DATE | DELIVERY MODE |
| 3 MONTHS | | | 01/17/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/748,364

Applicant(s)

WALKER ET AL.

Examiner

Hugh Jones

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/21/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-36 of U. S. Application 10/748,364, filed 12/30/2003, are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Kaenel in view of Applicant's Own Admission.

5. Von Kaenal et al. disclose incorporating maps into designs as discussed subsequently.

6. Von Kaenal et al. do not appear to disclose printing by the vendor.

7. AOA teaches the feature.

8. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Von Kaenal et al. with AOA because AOA discloses the advantages

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of using an external print service. See paragraphs 2-3 of the application (background of the art).

9. Von Kaenal et al. disclose:

making electronic map information available to a server computer system, the map information containing information covering a relatively large geographical area and being adapted to produce relatively high resolution maps (fig. 13, 21, 25),

in response to information received from a client computer system identifying a location within the relatively large geographical area, obtaining a relatively high resolution user map from the map information, the user map covering a relatively small geographical area that includes at least the identified location (fig. 13, 21, 25, 109, 110, 136, 166),

generating a lower resolution display map version of the user map, the display map being suitable for displaying at the client (col. 65, lines 19-67; screen vs print size),

transmitting the display map to the client for displaying to the user (fig. 13, 21, 25),

receiving a description of an electronic product design from the client, the description identifying at least a portion of the display map (fig. 13, 21, 25, 30-31, 33),

associating the identified portion of the display map with corresponding map information such that the product design will be printed using the higher resolution version of the display map (fig. 13, 21, 25, 30-31, 33),

further comprising storing the obtained user map is stored at the server (fig. 13, 21, 25),

further comprising storing the display version at the server (fig. 13, 21, 25),

further comprising retrieving the stored display version in response to a request from the user and transmitting the display version to the client computer system (fig. 13, 21, 25),

further comprising generating a thumbnail version of the display map and storing the thumbnail version at the server (fig. 13, 21, 25; screen vs print size),

further comprising retrieving the stored thumbnail version in response to a request from the user and transmitting the thumbnail version to the client computer system for viewing by the user (fig. 13, 21, 25; screen vs print size),

wherein the user map is based on location information supplied by the user for the purpose of obtaining a map (fig. 13, 21, 25),

wherein the user map is based on location information extracted from information previously supplied by the user for another purpose (fig. 13, 21, 25; col. 61, lines 8-23),

wherein the information received includes a zoom level to be used to obtain the user map (fig. 13, 21, 25, 92),

wherein the electronic product design has a defined map area and wherein the user map is obtained from the map information at a height and width ratio that corresponds to the height to width ratio of the map area in the electronic product design (fig. 13, 21, 25; col. 65, lines 19-67),

wherein the electronic product design has a defined map area and wherein the display map is generated to have a height and width ratio that corresponds to the height to width ratio of the available map area in the electronic product design (fig. 13, 21, 25).

10. Any inquiry concerning this communication or earlier communications from the examiner should be:

directed to: Dr. Hugh Jones telephone number (571) 272-3781,

Monday-Thursday 0830 to 0700 ET,

or

the examiner's supervisor, Kamini Shah, telephone number (571) 272-2279.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

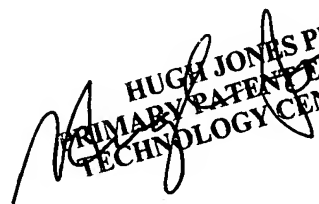
(703) 308-9051 (for formal communications intended for entry)

or (703) 308-1396 (for informal or draft communications, please label *PROPOSED* or *DRAFT*).

Dr. Hugh Jones

Primary Patent Examiner

January 5, 2007

 HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2102